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APPLICATION NO.	FILING DATE		FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/057,826	01/24/2002		Charles E. Tucker	021153-001400US	4198
20350	7590	09/08/2003			
		TOWNSEND AN	· · · · · EXAMINER		
TWO EMBA EIGHTH FLO		RO CENTER	CHANG, CELIA C		
SAN FRANC	CISCO, C	A · 94111-3834		ART UNIT	PAPER NUMBER
			1625	6	
				DATE MAILED: 09/08/2003	9

Please find below and/or attached an Office communication concerning this application or proceeding.

Application No.

Applicant(s)

10/057,826

Tucker et al.

Examiner

Office Action Summary

Celia Chang

Art Unit 1625



	The MAILING DATE of this communication appears on the co	over she	et with	the correspondence address				
	for Reply							
THE N	A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.							
	- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.							
- If NO p - Failure - Any re	period for reply specified above is less than thirty (30) days, a reply within the statutory period for reply is specified above, the maximum statutory period will apply and will expit to reply within the set or extended period for reply will, by statute, cause the applications by received by the Office later than three months after the mailing date of this community patent term adjustment. See 37 CFR 1.704(b).	oire SIX (6) N on to become	MONTHS fr	rom the mailing date of this communication. ONED (35 U.S.C. § 133).				
Status				!				
1) 💢	Responsive to communication(s) filed on Jun 12, 2003			·				
2a) 💢	This action is FINAL . 2b) \square This action is no	on-final.		ļ				
3) 🗆	Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.							
Disposit	tion of Claims							
4) 💢	Claim(s) <u>1-20</u>			is/are pending in the application.				
4	fa) Of the above, claim(s)							
5) 💢	Claim(s) 19 and 20			is/are allowed.				
6) 💢	Claim(s) 1			is/are rejected.				
7) 💢	Claim(s) 2-18			is/are objected to.				
	Claims							
	ation Papers							
9) 🗆	The specification is objected to by the Examiner.							
10)□	The drawing(s) filed on is/are a) accepted or b) objected to by the Examiner.							
	Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).							
11)	The proposed drawing correction filed on	is:	a) 🗆 a	approved b) \square disapproved by the Examiner.				
	If approved, corrected drawings are required in reply to this O)ffice acti	ion.					
12)	The oath or declaration is objected to by the Examiner.			·				
Priority	under 35 U.S.C. §§ 119 and 120							
13)□	Acknowledgement is made of a claim for foreign priority ur	nder 35	U.S.C.	§ 119(a)-(d) or (f).				
a) [☐ All b)☐ Some* c)☐ None of:							
	1. \square Certified copies of the priority documents have been in	received	1.					
• •	2. \square Certified copies of the priority documents have been in	received	I in Apr	olication No				
	3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).							
	*See the attached detailed Office action for a list of the certified copies not received.							
14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).								
a) In translation of the foreign language provisional application has been received. 15) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.								
Attachment(s)								
_	<u> </u>	terview Sum	nmary (PT(D-413) Paper No(s)				
2) No				t Application (PTO-152)				
3) Information Disclosure Statement(s) (PTO-1449) Paper No(s). 6) Other:								

Application/Control Number: 10/057,826 Page 2

Art Unit: 1625

DETAILED ACTION

1. Amendment and response filed by applicants in Paper no.8, dated June 12, 2003 have been entered and considered carefully.

2. The rejections of claim 1 under 35 USC 112 second and first paragraph is maintained for reason of record.

The newly amended claim 1 together with applicants argument further confuses the scope of the claim and what was enabled and support by the specification.

As it was clearly delineated it is unclear as to "what" is the product being made? Is it the compound of formula I, please not that formula I is only one diastereomer. Or is it any one of the "other" diastereomer of 1-(4-hydroxy-phenyl)-2-(4-hydroxy-4-phenyl-piperidin-1yl)-1-propanol? Does diastereomeric separate allowed in the process? Please note that claim 1 has no limitation as to other steps of diastereomer separation is excluded since only starting material, final product and catalyst are limited yet the term "comprising" allows incorporation of diastereomeric separation such as using tartaric acid to obtain a specific enantiomer.

Further, the claim is confusing as to how many starting material was employed? Only formula II or mixture of formula II and other enantiomer or formula II or the other enantiomer one at a time?

3. The objection of claims 2-18 and allowability of claims 19-20 of the previous office action are maintained.

Art Unit: 1625

4. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Celia Chang whose telephone number is 703-308-4702. The examiner can normally be reached on Monday through Thursday from 8:30 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman, can be reached on (703) 308-4698. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

WP/Chang *Sept. 5, 2003*

Celia Chang Primary Examiner Art Unit 1625